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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,627	03/23/2001	Peggy M. Stumer	2001P05288US	7108

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Siemens Corporation
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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 08/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/816,627 Applicant(s) Peggy M. Stumer et al.

Examiner Melur. Ramakrishnaiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on May 29, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-16 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3, 8-10, 15, and 16 is/are rejected.

7) Claim(s) 4-7 and 11-14 is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

6) Other: _____

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 and 8, are rejected under 35 U.S.C 102(e) as being anticipated by Tanaka et al. (US PAT: 6,243,442 B1, filed 12-19-1997, hereinafter Tanaka).

Regarding claim 1, Tanaka discloses a method for processing an emergency call made from behind a PBX/MLTS, the method comprising the steps of: within the PBX/MLTS determining whether the dialed digits represent an emergency number (fig. 4, col. 10 lines 14-30), assigning priority (fig. 6 col. 10 lines 8-13) within the PBX/MLTS to call determined to be an emergency call (col. 10 lines 63-67, col. 11 lines 1-67, col. 12 lines 1-35), such that call takes priority over other calls in traversing the private network (reads on PBX network connected to

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the tandem office or public network, see fig. 1) before reaching a public network (note: step 308 in fig. 3 implies priority to emergency call, col. 8 lines 50-65).

Regarding claim 8, Tanaka further discloses an apparatus (fig. 4) for processing an emergency call made from behind PBX/MLTS for determining whether dialed digits represent an emergency number (fig. 4, col. 10 lines 14-30), means for assigning priority (fig. 6, col. 10 lines 8-13) within the PBX/MLTS to a call determined to be an emergency call (fig. 7 col. 10 lines 48-67, col. 11 lines 1-67, col. 12 lines 1-35), such that call takes priority over other calls in traversing the private network (reads on PBX network connected to the tandem office or public network, see fig. 1) before reaching a public network (note: step 308 in fig. 3 implies priority to emergency call, col. 8 lines 50-65).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 9-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of Hoskinson et al. (US PAT: 5,339,351, hereinafter Hoskinson).

Regarding claims 2-3, 9-10, Tanaka teaches the following: storing a port number for each device/trunk in the PBX/MLTS and determining from which port the emergency call originated (col. 9 lines 63-67, col. 10 lines 1-30); but he does not teach the following: associating an

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emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point the ELIN associated with the port from which the emergency call originated.

However, Hoskinson discloses a emergency response system which teaches the following: associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point (reads on emergency response center 23 in fig. 1) the ELIN associated with the port from which the emergency call originated (col. 7 lines 18-20, fig. 3 col. 7 lines 56-68, col. 8 lines 1-4).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Tanaka's system to provide for the following: associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point the ELIN associated with the port from which the emergency call originated as this arrangement would enable the operator at the emergency response center to dispatch necessary help to the emergency caller as is well known in the art.

5. Claims 15-16, are rejected under 35 U.S.C 102(e) as being anticipated by Yrjana (US PAT:6,370,232 B1, filed 12-9-1998).

Regarding claim 15 and 16, Amano discloses a method for processing an emergency call made from behind a PBX/MLTS, the method comprising the steps of: within the PBX/MLTS (reads on exchange 10, fig. 2) determining dialed digits represent an emergency number (fig. 3, col. 5 lines 20-33), assigning priority (note: step 35 in fig. 3 implies priority to emergency call

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setup, col. 3 lines 9-15, claim 3) within PBX/MLTS to call determined to be emergency call without interrupting any existing calls (col. 5 lines 12-14).

Response to Arguments

6. Applicant's arguments filed on 5-29-2002 have been fully considered but they are not persuasive.

Rejection of claims 1 and 8 under 35 U.S.C 102(e) as being anticipated by Tanaka et al. (US PAT: 6,243,442, filed 12-19-1997, hereinafter Tanaka): Regarding rejection of claim 1, Applicant argues that "Tanaka does not teach or suggest the prioritizing of calls with in the private network. In fact, Tanaka specifically teaches away from this in Col. 12 ...". Notwithstanding the Applicant's interpretation of the Tanaka reference, Tanaka does teach the prioritizing of calls with in the private network (reads on PBX system) as evidenced by steps 306 and 308 of fig. 3. It basically illustrates releasing the occupied line to accommodate emergency 911 call in PBX system to roue the emergency call (col. 8 lines 50-65). This clearly teaches applicant's claim limitation: the prioritizing of calls with in the private network (PBX system of fig. 1). Applicant further argues that Tanaka thus states that even if a leased line is selected ... invention concerns the internal routing of emergency call over the private network, something not contemplated by Tanaka. Contrary to Applicant's interpretation of Tanaka's reference, steps 306 and 308 of fig. 3 teaches routing of emergency call through private network (reads on PBX system, col. 8 lines 50-65). Therefore, rejection of claim 1 is maintained as set forth in the office

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action above. Regarding rejection of claim 8, Applicant refers to arguments made in connection with claim 1. Therefore, explanation made in connection with claim 1 holds good.

Rejection of claims 2-3. And 9-10, under 35 U.S.C 103(a) as being unpatentable over Tanaka in view of Hoskinson et al. (US PAT: 5,339,351, hereinafter Hoskinson): Regarding rejection of these claims and Applicant's arguments on pages 7-10, Applicant argues that "Without providing evidence of incentive to combine, the combination of references is based on hindsight. To draw on hindsight knowledge ... illogical and inappropriate process in which to determine patentability". In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant further argues that "The simplicity of invention does not remove examiner's duty of providing evidence of teaching or motivation. "Combining prior art references without evidence of such a suggestion, teaching, or motivation ...". In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tanaka teaches the following: storing a port number for each device/trunk in the PBX/MLTS and determining from which port the emergency call originated (col. 9 lines 63-67, col. 10 lines 1-30); but he does not teach the following: associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point the ELIN associated with the port from which the emergency call originated.

However, Hoskinson discloses a emergency response system which teaches the following: associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point (reads on emergency response center 23 in fig. 1) the ELIN associated with the port from which the emergency call originated (col. 7 lines 18-20, fig. 3 col. 7 lines 56-68, col. 8 lines 1-4).

Therefore, one of ordinary skill in the art at the time invention was made would be motivated to combine Tanaka reference with Hoskinson which teaches associating an emergency location identification number (ELIN) with each port equipment number, and transmitting to a public safety answering point (reads on emergency response center 23 in fig. 1) the ELIN associated with the port from which the emergency call originated as explained above, for it facilitates the operator at emergency response center to dispatch necessary emergency help to the emergency caller as is well known in the art (see col. 1 lines 29-35 of '351).

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Regarding rejection of claims 2-3 and 9-10, Applicant further argues that “Hoskinson teaches the location identification module is ... is very vague teaching and does not even close to suggesting the association of port equipment numbers with emergency location identification numbers set out in the rejected claims”. Contrary to Applicant’s interpretation of the Hoskinson reference, Hoskinson teaches the following: associated with each residence and the PBX (or each telephone of the PBX if the PBX covers a large area) is a location identification module that stores information about the location of the associated telephone or telephones, i.e., the address of the residence, the address of the PBX, or the location of the PBX phone (col. 5 lines 30-45). This clearly teaches the limitation: association of port equipment numbers with emergency location identification numbers as shown above. In view of this, rejection of claims 2-3 and 9-10, is maintained.

7. In view of Applicant’s arguments regarding claims 4-7 and 11-14: Claims 4-7 and 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on Monday to Friday from 7 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry)

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Or:

(703) 305-9508 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).


Melur. Ramakrishnaiah

PRIMARY EXAMINER

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